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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,595	12/18/2001	Akane Okada	217484US0	6197

22850 7590 05/15/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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HARTLEY, MICHAEL G

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/15/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,595

Applicant(s)

OKADA ET AL.

Examiner

Michael G. Hartley

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Accetta (US 3,907,991).

Accetta discloses a solution comprising fluorescein sodium, 0.75% by weight in glycerol (i.e., glycerin), see example 4. The composition is for staining plaque on the teeth. The composition contains the same components as claimed, i.e., 0.75% fluorescein sodium (which is within the claimed amount) in a solvent, i.e., glycerol, as set forth in claim 2, of the application.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Townsend III (US 4,249,412).

Townsend III discloses a solution comprising fluorescein sodium, 0.025% by weight in a solvent/solvents, i.e., ethylene glycol and water, see column 4, lines 14-29. The composition contains the same components as claimed, i.e., 0.025% fluorescein sodium (which is within the claimed amount) in a combination of solvents, such as those in claim 2 of the application.

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Rueggeberg (US 6,391,281).

Rueggeberg discloses a solution for examination of teeth comprising fluorescein sodium in saline solution at a concentration of 1mg/ml or 1.0% by weight, see example 1, column 8, lines 55-64. The

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composition contains the same components as claimed, i.e., 1.0 % fluorescein sodium (which is within the claimed amount) in a solvent, i.e., water, as set forth in claim 2 of the application.

**NOTE:** A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The intended use of the claimed compositions has not been given patentable weight in the examination to differentiate over the cited art. The compositions of the prior art cited herein contain the same components as claimed (i.e., fluorescein sodium and a solvent), thus, must be capable of performing the intended use.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Townsend III (US 4,249,412) or Rueggeberg (US 6,391,281).

Townsend III and Rueggeberg disclose a solution comprising fluorescein sodium and a solvent as set forth above.

Townsend III and Rueggeberg fail to specifically disclose the entire concentration range as claimed and all of the same solvents.

Townsend III teaches that the fluorescein sodium may be in a range of 0.025-1.0 %, see column 1, lines 50+ and teaches that water is the preferred solvent, see column 2, lines 29+. Also, the surfactants contained therein include ones, which are non-toxic, and therefore capable of performing the intended use, see column 3, lines 48-55.

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Rueggeberg teaches that the amount of fluorescein may be in the range of 0.001 to 10%, see column 6, lines 30-34. Rueggeberg also teaches that various solvents may be used, e.g., ethanol, acetone, etc., see column 7, lines 50+.

It would have been obvious to one of ordinary skill in the art to modify the amount of fluorescein in the solutions disclosed by either Townsend III and Rueggeberg to amounts as encompassed by the claimed range because both teach a range in the amount of fluorescein which may be used to optimize the staining capability of the composition, wherein said range clearly encompasses and overlaps the claimed range. Further it would have been obvious to employ the solvents as claimed in the fluorescein solutions of Townsend III and Rueggeberg because both teach the use of solvents as claimed, including water, ethanol, acetone, etc., as equivalent solvents.

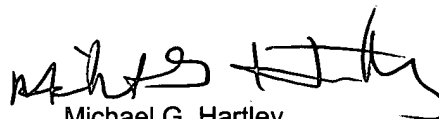
### **Conclusion**

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Hartley whose telephone number is (703) 308-4411. The examiner can normally be reached on M-F, 7:30-5, off alternative Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose G. Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Michael G. Hartley  
Primary Examiner  
Art Unit 1616

MH  
May 15, 2003